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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------------------------------------------|-------------|----------------------|---------------------------|------------------|
| 10/727,095 | 12/03/2003 | Anthony Joseph Maves | 1388-031/63295 | 6056 |
| 25212 | 7590 | 10/21/2005 | EXAMINER BUI, PHUONG T | |
| DOW AGROSCIENCES LLC 9330 ZIONSVILLE RD INDIANAPOLIS, IN 46268 | | | ART UNIT 1638 | PAPER NUMBER |

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|----------------------------------------------|--|
| Office Action Summary | Application No. 10/727,095 | Applicant(s) MAVES, ANTHONY JOSEPH | |
| | Examiner Phuong T. Bui | Art Unit 1638 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>3/24/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 1-33 are pending and are examined in the instant Office action.

Drawings

2. No drawings have been submitted in the instant application.

Claim Rejections - 35 USC § 112, 2nd paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 23 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

In claim 23, the enzymes must be expressed to obtain the modified fatty acid metabolism or the modified carbohydrate metabolism phenotype.

In claim 25, it is suggested that "as compared to an untransformed corn plant" be inserted at the end of the claim to provide comparative basis.

Clarification and/or correction of all above issues are required.

Claim Rejections - 35 USC § 112, 1st paragraph, written description

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 9-10 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the

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application was filed; had possession of the claimed invention. The claimed invention lacks written description under current written description guidelines. The claims are drawn to corn progeny plants having undisclosed identifying characteristics whereby only one parent is known, and none of the morphological and physiological characteristics of the second parent is known. Applicant should note that no identifying characteristics are set forth for the F1 progeny. If the claimed F1 plant itself cannot be identified by characteristics clearly disclosed in the specification, then it is not even possible to determine whether a plant of unknown parentage is or is not covered by the claim. Thus, F1 progeny plants which are not disclosed by any identifying characteristics are not considered to be possessed by Applicant. There are insufficient relevant identifying characteristics to allow one skilled in the art to predictably determine the genomic structure or phenotypic characteristics of the plant obtained at the F1 generation, absent further guidance. The deposited seed has a defined set of genes and corresponding traits, none of which are necessarily retained in the claimed hybrid. Accordingly, there is a lack of adequate description for the claimed progeny plants, and in view of the level of knowledge and skill in the art, one skilled in the art would not recognize from the disclosure that Applicant was in possession of the claimed invention at the time of filing. Accordingly, the claimed invention lacks adequate written description under current written description guidelines (see Written Description Requirement published in Federal Register/ Vol. 66, No. 4/ Friday, January 5, 2001/ Notices; p. 1099-1111).

Claim Rejections - 35 USC § 102 and 35 USC § 103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hotchkiss (US Pat. No. 6476299 (A)). The prior art teaches a corn plant which shares some of the characteristics disclosed for the deposited variety including leaf, glume, anther, silk, cob and kernel color (Table 5). While the corn variety of the prior art has a different line designation from the corn variety of the instant application, there are insufficient identifying characteristics set forth in the claims to distinguish the claimed plants from those of the prior art. Even at the F1 progeny level, no identifying characteristics are recited to distinguish Applicant's F1 plants from those of the prior art. The claims do not specifically recite a plant whereby all of the physiological and morphological characteristics of the deposited parent are retained. The methods used to produce the claimed plants involve an undetermined number of crosses and not all of the distinguishing characteristics of the deposited parent from the initial cross are

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necessarily retained. None of the identifying features which distinguish Applicant's plants from those of the prior art are set forth (see written description rejection above). The method of producing the plant, namely using deposited corn variety as one parent would not confer a unique property to the resultant corn which would distinguish it from the prior art corn. Accordingly, the claimed invention is anticipated by, or in the alternative, is obvious in view of the prior art. See *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejected over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products. Since the Patent Office does not have the facilities to examine and compare the plant of Applicant's with that of the prior art, the burden of proof is upon the Applicant to show an unobvious distinction between the claimed plant and the plant of the prior art. See *In re Best*, 562F.2d 1252, 195 USPQ 430 (CCPA 1977).

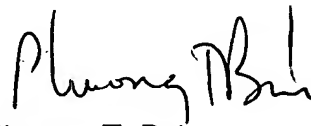
Conclusion

8. Claims 1-8, 11-22, 24 and 26-33 are allowable.
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong T. Bui whose telephone number is 571-272-0793.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on 571-272-0745. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Phuong T. Bui
Primary Examiner
Art Unit 1638
10/17/05

10/14/05